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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,708	12/04/2003	Yasuo Mori	00862.023354	7041
5514 7590 10/07/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
LUDWIG, MATTHEW J				
ART UNIT		PAPER NUMBER		
2178				
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10/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/726,708

**Applicant(s)**

MORI ET AL.

**Examiner**

MATTHEW J. LUDWIG

**Art Unit**

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 18, 20 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 18, 20 and 26-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to the amendment received 6/20/2008.
2. Claims 1-12, 18, 20, 26-33, are currently pending in the case, with claims, 1, 7, 18, 20, and 23 being the independent claims.
3. Claims 1-12, 18, 20, 26-33 remain rejected under 35 U.S.C. 102(e) as being anticipated by Masuda pursuant to applicant's amendments.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-12, 18, 20, 26-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Masuda et al., US Pat. Pub. US 2002/0087602 filed (9/10/01).**

**In reference to independent claim 1, Masuda teaches:**

*'an instruction accepting unit which accepts an instruction of inserting designated data into a designated position of the document from a user'.* See figure 11 which shows a detailed example in which an original electronic source document from which a thumbnail image has been moved to the composed window is indicated. The thumbnail images of 1/3 and 2/3 pages on the composed window are selected, a thumbnail image on the collection window and a thumbnail image on the collection window which correspond to the thumbnail

images on the composed window, are displayed as frames or semitransparent images, thereby indicating that the thumbnail images are selected. See page 7, [0124 through 0127]. The reference mentions a collection made up of a pages which could be moved or divided into other collection windows. The claim states a 'chapter' being made up of at least one page. The examiner is broadly interpreting a collection as taught in the Masuda reference as a chapter of pages. Pages 8-11 illustrate different tables that include information related to page indexes. It is the page index and the source documents which include designated data based upon designated positions of the document and edits of the documents by the user.

*'an editor which edits the document so as to insert a new chapter containing a page formed with the designated data into the designated position of the document in response to a determination that a type of the designated data is data....')*. The editor taught within the reference to Masuda includes options related to moving pages from one chapter to another and rotating pages within chapters. See pages 8 and 9. The determination, as presently claimed, is made by the editor and therefore the reference to Masuda discloses the necessary steps and determinations based upon different data formats and types. See pages 6-9.

**In reference to dependent claim 2,** Masuda teaches:

The document management software (e-binder builder) provides a display controller to create chapters or collections of documents and edit documents. See Masuda, page 5-6. Furthermore, the reference discloses a processing unit for editing the document in accordance with a page and a designation of a position accepted on the display controlled by the e-binder builder.

**In reference to dependent claim 3 and 4, Masuda teaches:**

Figure 14 illustrates collection attributes inserted into different collections which would allow for the new collection to inherit attributes from the old collection. See figure 14 and page 8, [0135 through 0139].

**In reference to dependent claim 5, Masuda teaches:**

The bookbinding portion is a portion that holds the generated electronic document made by converting the generated electronic document made by converting the generated electronic document composed of each electronic source document page obtained from the PAGEINDEX portion for managing the pages of the generated electronic document into a predetermined file format. See page 5, [0093 through 0095].

**In reference to dependent claim 6, Masuda teaches:**

See figure 11 which shows a detailed example in which an original electronic source document from which a thumbnail image has been moved to the composed window is indicated. The thumbnail images of 1/3 and 2/3 pages on the composed window are selected, a thumbnail image on the collection window and a thumbnail image on the collection window which correspond to the thumbnail images on the composed window, are displayed as frames or semitransparent images, thereby indicating that the thumbnail images are selected. See page 7, [0124 through 0127]. The reference mentions a collection made up of a pages which could be moved or divided into other collection windows. The claim states a 'chapter' being made up of at least one page. The examiner is broadly interpreting a collection as taught in the Masuda reference as a chapter of pages.

**In reference to claims 7-12**, the claims recite similar instructions for carrying out the document processing apparatus claims numbered 1-6, respectively. Therefore, the claims are rejected under similar rationale.

**In reference to claims 18, 20**, the claims recite similar instructions for carrying out the document apparatus claims numbered 1-6, respectively. Therefore, the claims are rejected under similar rationale.

**In reference to dependent claim 26**, Masuda teaches:

The document management software (e-binder builder) provides a display controller to create chapters or collections of documents and edit documents. See Masuda, page 5-6. Furthermore, the reference discloses a processing unit for editing the document in accordance with a page and a designation of a position accepted on the display controlled by the e-binder builder.

**In reference to claims 27, 28, 29, and 30**, the claims recite similar instructions for carrying out the document apparatus claims numbered 1-6, respectively. Therefore, the claims are rejected under similar rationale.

**In reference to dependent claim 31-33**, Masuda teaches:

The editor taught within the reference to Masuda includes options related to moving pages from one chapter to another and rotating pages within chapters. See pages 8 and 9. The determination, as presently claimed, is made by the editor and therefore the reference to Masuda discloses the necessary steps and determinations based upon different data formats and types. See pages 6-9.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-12, 18 and 20-25 have been considered but are not persuasive.

Applicant amended the claims and thus changed the scope of the invention when read as a whole. The rejection under 35 U.S.C. 102(c) as being anticipated by Masuda has been maintained and modified based upon the amendments to the claims. Applicant argues on page 15 and 16 that the reference to Masuda fails to disclose or suggest at least the features of accepting from a user an instruction of inserting designated data into a designated position of a structured document, and editing the structured document so as to insert a new chapter containing a page formed with the designated data into the designated position of the document in response to a determination that a type of the designated data is data other than image data, and so as to insert a page formed with the designated data into the designated position of the document in an existing chapter in response to a determination that the type of the designated data is image data. However, the reference to Masuda discloses shows a detailed example in which an original electronic source document from which a thumbnail image has been moved to the composed window is indicated. The thumbnail images of 1/3 and 2/3 pages on the composed window are selected, a thumbnail image on the collection window and a thumbnail image on the collection window which correspond to the thumbnail images on the composed window, are displayed as frames or semitransparent images, thereby indicating that the thumbnail images are selected. See page 7, [0124 through 0127]. The reference mentions a collection made up of a pages which could be moved or divided into other collection windows. The claim states a 'chapter' being made up of at least one page. The examiner is broadly interpreting a collection as taught in the

Masuda reference as a chapter of pages. Pages 8-11 illustrate different tables that include information related to page indexes. It is the page index and the source documents which include designated data based upon designated positions of the document and edits of the documents by the user. The editor taught within the reference to Masuda includes options related to moving pages from one chapter to another and rotating pages within chapters. See pages 8 and 9. The determination, as presently claimed, is made by the editor and therefore the reference to Masuda discloses the necessary steps and determinations based upon different data formats and types. See pages 6-9.

In reference to independent claim 20, applicant argues that Masuda, alone or in any permissible combination, is not seen to disclose or to suggest the features of accepting an instruction from a user to divide a chapter contained in the document data, in response to the accepted instruction, obtaining data containing pages constituting a portion of the chapter instructed to be divided, in response to obtaining the data containing pages, generating a new chapter which is different from chapters currently contained in the document data and which contains the obtained pages. The reference to Masuda discloses a means of creating new collections/chapters utilizing user manipulations of pages and through the utilization of source document mapping. Any changes in pages from difference collections would create, modify, or add/delete pages of a collection/chapter. Figures 10a through 13 illustrate examples of creating new chapters, dividing chapters, and ultimately the modification of chapters through the use of document data and user changes. Support could be found on pages 7-10 of the reference to Masuda. A description of a chapter/collection could be found on page 10.



***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. LUDWIG whose telephone number is (571)272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen S. Hong/  
Supervisory Patent Examiner, Art Unit  
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